

All communications respecting this case should identify it by number and names of parties.



**U.S. DEPARTMENT OF COMMERCE,  
Patent and Trademark Office**

Address: BOX INTERFERENCE  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Telephone: (703)557-4007

Facsimile: (703)557-8642

MAILED

JUN - 1 1993

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Applicants: Fraley et al.  
Serial No.: 07/625,637  
Filed: 12/07/90  
For: CHIMERIC GENES FOR  
TRANSFORMING PLANT CELLS  
USING VIRAL PROMOTERS  
Accorded Benefit of: U.S.  
Serial Nos. 06,931,492 filed  
11/17/86, 06/485,568 filed  
04/15/83 and 06/458,414  
filed 01/17/83

In accordance with the decision (Paper No. 59) with respect to Fraley Motion No. 7, this interference is hereby redeclared as follows:

1. Two new claims, Fraley claim 21 and Comai claim 59, are designated as corresponding to new count 2 (see below), on condition that they be properly added in their respective applications. The amendment of Fraley claims 1, 4 and 7 is noted (Fraley Motion No. 7, Exhibit 5).

2. Original count 1 is replaced by count 2 (proposed count A) which reads as follows:

Count 2

A DNA construct comprising:

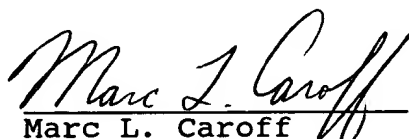
(A) a CaMV promoter selected from the group consisting of (1) a CaMV 35S promoter isolated from CaMV protein-encoding DNA sequences and (2) a CaMV 19S promoter isolated from CaMV protein-encoding DNA sequences, and

(B) a DNA sequence of interest heterologous to (A), wherein (B) is under the regulatory control of (A) when said construct is transcribed in a plant cell.

The claims of the parties which correspond to this count are:

Fraley et al.: Claims 1, 2, 4-11 and 13-21

Comai et al.: Claims 39-59

  
Marc L. Caroff  
Examiner-in-Chief  
(703) 557-4061

MLC:clm

COPY

Tabulation marks

<b>I. PATENT OPPOSED</b>		for EPO only	
	Opp. No.	OPPO (1)	
Patent No.	EP 0 131 623		
Application No.	84900782.8		
Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)	6th March 1991		
Title of the invention:  Chimeric Genes Suitable for Expression in Plant Cells			
<b>II. PROPRIETOR OF THE PATENT</b> first named in the patent specification		Monsanto Company	
Opponent's or representative's reference (max. 15 spaces)		OREF	
<b>III. OPPONENT</b>	OPPO (2)		
Name	Unilever PLC		
Address	Unilever House Blackfriars London EC4 4BQ England		
State of residence or of principal place of business	United Kingdom		
Telephone/Telex	071 822 5252	28395 UNIL G	
Multiple opponents	<input type="checkbox"/> further opponents see annex	<input type="checkbox"/>	
<b>IV. AUTHORIZATION</b>	OPPO (9)		
1. REPRESENTATIVE (Name only one representative to whom notification is to be made)	Clare Matthews		
Name	Keith W Nash & Co		
Address of place of business	Pearl Assurance House, 90-92 Regent Street Cambridge, CB2 1DP, England		
Telephone/Telex	(0223) 355477	BLUCAM-817343	
Additional representative(s)	<input checked="" type="checkbox"/> (on additional sheet/see authorization)      OPPO (5)		
2. EMPLOYEE(S) of the opponent authorized for these opposition proceedings under Art 133(3) EPC	Name(s):		
AUTHORIZATION(S) to 1.2.	<input checked="" type="checkbox"/> is/are enclosed		
	<input type="checkbox"/> has/have been registered under No.		
	<input type="checkbox"/> will be filed within three months (rule 101(4) EPC)		

	for EPO only
<p><b>V. Opposition is filed against</b></p> <p>—the patent as a whole <input checked="" type="checkbox"/></p> <p>—the claims No. <span style="border: 1px solid black; display: inline-block; width: 150px; height: 1.2em; vertical-align: middle;"></span></p>	
<p><b>VI. GROUNDS FOR OPPOSITION:</b></p> <p>Opposition is based on the following grounds:</p> <p>(a) the subject matter of the European patent opposed is not patentable (Art. 100(a) EPC) because:</p> <p style="margin-left: 40px;">—it is not new (Art. 52(1); 56 EPC), <span style="float: right;"><input type="checkbox"/></span></p> <p style="margin-left: 40px;">—it does not involve an inventive step (Art. 52(1); 56 EPC), <span style="float: right;"><input checked="" type="checkbox"/></span></p> <p style="margin-left: 40px;">—patentability is excluded on other grounds, <span style="float: right;"><input type="checkbox"/></span></p> <p style="margin-left: 100px;">i.e. <span style="border: 1px solid black; display: inline-block; width: 100px; height: 1.2em; vertical-align: middle;"></span></p> <p>(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b), EPC; see Art. 83 EPC) <span style="float: right;"><input checked="" type="checkbox"/></span></p> <p>(c) the subject matter of the patent opposed extends beyond the content of the application/ the earlier application as filed (Art. 100(c) EPC; see 123(2) EPC) <span style="float: right;"><input type="checkbox"/></span></p>	
<p><b>VII. FACTS AND ARGUMENTS</b> (Rule 55(c) EPC) presented in support of the opposition are submitted herewith on a separate sheet (annex 1)</p>	<input checked="" type="checkbox"/>
<p><b>VIII. ORAL PROCEEDINGS</b></p> <p>—are requested for the event that the patent opposed is not to be revoked as requested on the written submissions. <span style="float: right;"><input checked="" type="checkbox"/></span></p> <p>—are—presently—not requested. <span style="float: right;"><input type="checkbox"/></span></p>	
<p><b>IX. OTHER REQUESTS:</b></p> <p>In accordance with Art. 104 EPC an award of costs in the Opponent's favour is requested should it be necessary to attend oral proceedings or to present further evidence.</p> <p>It is requested to be allowed to present evidence in support of opposition in the form of oral or written testimony by experts or witnesses should such evidence be considered necessary.</p>	

		for EPO only
<b>X. EVIDENCE presented</b>		
<b>A. Publications:</b>		
	cited in patent specification, therefore not enclosed	= <input type="text" value="2"/>
	enclosed	= <input type="text" value="1"/>
	(neither cited in patent specification, nor enclosed	= <input type="text" value="0"/>
See Annex 2		Date of public. available (R.59)
1	Relates to claim(s) No.	
	Particular relevance (page, column, line, fig.):	<input type="text"/>
2	Relates to claim(s) No.	
	Particular relevance (page, column, line, fig.):	<input type="text"/>
3	Relates to claim(s) No.	
	Particular relevance (page, column, line, fig.):	<input type="text"/>
4	Relates to claim(s) No.	
	Particular relevance (page, column, line, fig.):	<input type="text"/>
5	Relates to claim(s) No.	
	Particular relevance (page, column, line, fig.):	<input type="text"/>
Continued on separate sheet (annex 2)		
<b>B. Other evidence:</b>		
Continued on separate sheet (annex 2)		<input type="text"/>

for EPO only

XI. PAYMENT OF THE OPPOSITION FEE is made

- ☒ as indicated in the enclosed voucher for settlement of fees (EPO Form 1010)  
☐

XII. LIST OF ENCLOSED DOCUMENTS

Enclo-  
sure No.

No. of  
copies

- |  |                                     |  |                                |                  |
|--|-------------------------------------|--|--------------------------------|------------------|
| 0  | <input checked="" type="checkbox"/> | Copies of this form for notice of opposition   | <input type="text" value="2"/> | (min. 1)         |
| 1  | <input checked="" type="checkbox"/> | Facts and arguments (see VII.)   | <input type="text" value="2"/> | (min. 2)         |
| 2  | <input type="checkbox"/>            | Separate indication of further evidence (see X)  | <input type="text"/>           | (min. 2)         |
| Copies of documents presented as evidence (see X): |                                     |  |                                |                  |
| 3a   | <input checked="" type="checkbox"/> | —Publications  | <input type="text" value="2"/> | (min. 2 of each) |
| 3b   | <input type="checkbox"/>            | —Other documents   | <input type="text"/>           | (min. 2 of each) |
| 4  | <input checked="" type="checkbox"/> | Signed authorization(s) (see IV)   | <input type="text" value="1"/> |                  |
| 5  | <input type="checkbox"/>            | Voucher for the settlement of fees (see XI) — Fees already paid,<br>see attached voucher |                                |                  |
| 6  | <input type="checkbox"/>            | Cheque   |                                |                  |
| 7  | <input type="checkbox"/>            | Additional sheet   | <input type="text"/>           | (min. 2)         |
| 8  | <input checked="" type="checkbox"/> | Receipt for documents (EPO Form 1037)  | <input type="text" value="2"/> |                  |
| 9  | <input type="checkbox"/>            | Other (please specify here)  | <input type="text"/>           |                  |

XIII. SIGNATURE  
of opponent or representative

Clare Matthews  
Clare Matthews

Place Cambridge, England

Date 4th December 1991

To the  
EUROPEAN PATENT OFFICE  
Erhardtstr. 27  
D-8000 Munich 2

001  
**NOTICE OF OPPOSITION AGAINST A EUROPEAN PATENT**

Tabulation marks

		for EPO only	
<b>I. PATENT OPPOSED</b>		Opp. No.	OPPO (1)
Patent No.		0 131 623	
Application No.		84 900782.8	
Date of mention of the grant in the European Patent Bulletin (Art. 97(4), 99(1) EPC)		06.03.91	
Title of the invention: CHIMERIC GENES SUITABLE FOR EXPRESSION IN PLANT CELLS			
<b>II. PROPRIETOR OF THE PATENT</b>			
first named in the patent specification      MONSANTO COMPANY			
Opponent's or representative's reference (max. 15 spaces)		OREF	
<b>III. OPPONENT</b>		OPPO (2)	
Name	AGRICULTURAL GENETICS COMPANY LTD. 154 Science Park Milton Road Cambridge CB4 4GG		
Address			
State of residence or of principal place of business	GB		
Telephone/Telex	0223 420882		
Multiple opponents	<input type="checkbox"/> further opponents see annex <input type="checkbox"/>		
<b>IV. AUTHORISATION</b>			
<b>1. REPRESENTATIVE</b> (Name only one representative to whom notification is to be made)		OPPO (9)	
Name	SOPHIE EMMA HORTON		
Address of place of business	ELKINGTON AND FIFE PROSPECT HOUSE, 8 PEMROKE ROAD SEVENOAKS, KENT, TH13 1XR		
Telephone/Telex	071-405-3505	27136	
Additional representative(s)	<input checked="" type="checkbox"/> (Name(s) of representative/see authorisation)		OPPO (5)
<b>2. EMPLOYEE(S) of the opponent authorised for these opposition proceedings under Art. 133(3) EPC</b>		Name(s):	
<b>AUTHORISATION(S) to 1./2.</b>		<input checked="" type="checkbox"/> is/are enclosed	
		<input type="checkbox"/> has/have been registered under No. <span style="border: 1px solid black; display: inline-block; width: 100px; height: 1.2em; vertical-align: middle;"></span>	

<p><b>V. Opposition is filed against</b></p> <p>— the patent as a whole <input checked="" type="checkbox"/></p> <p>— the claims No. <input type="text"/></p>	<p>for EPO only</p>
<p><b>VI. GROUNDS FOR OPPOSITION:</b></p> <p>Opposition is based on the following grounds:</p> <p>(a) the subject-matter of the European patent opposed is not patentable (Art. 100(a) EPC) because:</p> <p>— it is not new (Art. 52(1); 54 EPC). <input checked="" type="checkbox"/></p> <p>— it does not involve an inventive step (Art. 52(1); 56 EPC). <input checked="" type="checkbox"/></p> <p>— patentability is excluded on other grounds, <input type="checkbox"/></p> <p>i. e. <input type="text" value="Art."/></p> <p>(b) the patent opposed does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b), EPC; see Art. 83 EPC) <input checked="" type="checkbox"/></p> <p>(c) the subject-matter of the patent opposed extends beyond the content of the application/the earlier application as filed (Art. 100(c) EPC; see 123(2) EPC) <input checked="" type="checkbox"/></p>	
<p><b>VII. FACTS and ARGUMENTS</b> (Rule 55(c) EPC) presented in support of the opposition are submitted herewith on a separate sheet (annex 1)</p>	<input checked="" type="checkbox"/>
<p><b>VIII. ORAL PROCEEDINGS</b></p> <p>— are requested for the event that the patent opposed is not to be revoked as requested on the written submissions. <input checked="" type="checkbox"/></p> <p>— are — presently — not requested. <input type="checkbox"/></p>	
<p><b>IX. OTHER REQUESTS:</b></p>	



**XI. PAYMENT OF THE OPPOSITION FEE is made**

☐ as indicated in the enclosed voucher for settlement of fees (EPO Form 1010)

☒ the amount of DM 700 is to be deducted from the Deposit A/C of Elkington and Fife in the EPO No: 2805.0051.

**XII. LIST OF ENCLOSED DOCUMENTS**Enclo-  
sure No.

No. of copies

- |  |                                     |   |                                |                  |
|--|-------------------------------------|---|--------------------------------|------------------|
| 0  | <input checked="" type="checkbox"/> | Copies of this form for notice of opposition    | <input type="text" value="2"/> | (min. 1)         |
| 1  | <input checked="" type="checkbox"/> | Facts and arguments (see VII.)                  | <input type="text" value="2"/> | (min. 2)         |
| 2  | <input type="checkbox"/>            | Separate indication of further evidence (see X) | <input type="text"/>           | (min. 2)         |
| Copies of documents presented as evidence (see X): |                                     |   |                                |                  |
| 3a   | <input checked="" type="checkbox"/> | — Publications                                  | <input type="text" value="2"/> | (min. 2 of each) |
| 3b   | <input type="checkbox"/>            | — Other documents                               | <input type="text"/>           | (min. 2 of each) |
| 4  | <input type="checkbox"/>            | Signed authorisation(s) (see IV)                | <input type="text"/>           |                  |
| 5  | <input type="checkbox"/>            | Voucher for the settlement of fees (see XI)     |                                |                  |
| 6  | <input type="checkbox"/>            | Cheque  |                                |                  |
| 7  | <input type="checkbox"/>            | Additional sheet                                | <input type="text"/>           | (min. 2)         |
| 8  | <input type="checkbox"/>            | Receipt for documents (EPO Form 1037)           | <input type="text" value="2"/> |                  |
| 9  | <input type="checkbox"/>            | Other (please specify here)                     | <input type="text"/>           |                  |

**XIII. SIGNATURE**  
of opponent or representative


Place LONDON, ENGLAND

Date 6th December 1991

SOPHIE EMMA HORTON  
EUROPEAN PATENT ATTORNEY  
ELKINGTON AND FIFE

SOPHIE EMMA HORTON  
European Patent Attorney  
Elkington and Fife

X. EVIDENCE presented		for EFO only	
A. Publications:		(cited in patent specification, therefore not enclosed) = <input type="checkbox"/> 2  (enclosed) = <input type="checkbox"/> 1  (neither cited in patent specification nor enclosed) = <input type="checkbox"/> 0	Date of public./ available (R.59)
1	Relates to claim(s) No.		
	Particular relevance (page, column, line, fig.):	<input type="checkbox"/>	
2	Relates to claim(s) No.		
	Particular relevance (page, column, line, fig.):	<input type="checkbox"/>	
3	Relates to claim(s) No.		
	Particular relevance (page, column, line, fig.):	<input type="checkbox"/>	
4	Relates to claim(s) No.		
	Particular relevance (page, column, line, fig.):	<input type="checkbox"/>	
5	Relates to claim(s) No.		
	Particular relevance (page, column, line, fig.):	<input type="checkbox"/>	
Continued on separate sheet (annex 2)		<input type="checkbox"/>	
B. Other evidence:			
Continued on separate sheet (annex 2)		<input type="checkbox"/>	

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

COMAI et al.

v.

FRALEY et al.

)  
)  
) Interference No.  
) 102,890  
)  
) Examiner-in-Chief  
) Mark L. Caroff  
)  
) **BOX INTERFERENCE**

**FRALEY MOTION NO. 6**

\* \* \* \* \*

**PRELIMINARY MOTION BY FRALEY ET AL. UNDER  
37 C.F.R. §1.634 TO CORRECT THE INVENTORSHIP OF THE APPLICATION**

Hon. Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

**I. STATEMENT OF RELIEF REQUESTED**

The party Fraley et al. ("Fraley") submits this motion under 37 C.F.R. §1.634 to correct the inventorship of its involved application Serial No. 07/625,637. This motion is submitted to change the inventorship to include a third inventor, Robert B. Horsch. This motion is accompanied by (a) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred (Exhibit 1); (b) a declaration by each actual inventor as required by 37 C.F.R. § 1.63 (Exhibit 2); (c) the fee set forth in 37 C.F.R. § 1.17(h); and (d) the written consent of the assignee, Monsanto Company (Exhibit 3).

## II. STATEMENT OF MATERIAL FACTS

1. On January 17, 1983, three applications were filed, U.S. Serial No. 458,414 ("the '414 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; U.S. Serial No. 458,411 ("the '411 application"), which listed as inventors Robert T. Fraley and Stephen G. Rogers; and U.S. Serial No. 458,402 ("the '402 application"), which listed as inventors Robert T. Fraley, Stephen G. Rogers and Robert B. Horsch. Each application incorporated the other application by reference. The '414 application originally claimed, *inter alia*, chimeric genes. The '411 application originally claimed, *inter alia*, a chimeric piece of DNA or a plasmid. The '402 application originally claimed, *inter alia*, a method of creating transformed plant cells and differentiated plants.

2. On April 15, 1983, U.S. Serial No. 458,568 ("the '568 application") was filed as a continuation-in-part application of the '414 application. This application incorporated the '414 application by reference. This application as originally filed contained a dependent claim directed to a differentiated plant.

3. On November 17, 1986, U.S. Serial No. 931,492 ("the '492 application") was filed as a continuation-in-part application of the '568 application. This application also incorporated the '568 application by reference. The '492 application as originally filed contained independent claims directed to differentiated plants.

4. On December 7, 1990, U.S. Serial No. 625,637 ("the '637 application") was filed as a file wrapper continuation of the '492 application. This application is the application of party Fraley et al. which is subject to the present interference.

5. A continuation application of the '411 application was filed on October 4, 1985 (U.S. Serial No. 783,336) and a continuation application of the '402 application was filed on October 30, 1985 (U.S. Serial No. 793,486). The prosecution of both of these cases has been suspended pending the declaration of one or more interferences.

6. In reviewing the '637 application in preparation for the preliminary motion stage of the present interference, applicants' attorney recognized that claims 10-18 did not correspond to the count (See Fraley's Motion No. 5). Moreover, it was recognized that claims 16-18, which are directed to differentiated plants, were invented by the same inventive entity as the '402 (and thus, the 793,486 application), i.e., Fraley, Rogers, and Horsch.

7. Rogers and Fraley are the inventors of chimeric genes containing either the 35S and 19S promoter, and are the inventors of plasmids containing these chimeric genes. Horsch's contribution was in selecting and regenerating differentiated plants containing the chimeric genes invented by Rogers and Fraley. The contribution of Horsch was always recognized by the fact that Horsch

was listed as a joint inventor in the '402 application. This disclosure was incorporated by reference into the '414, '568, '492 and '637 applications, but it was not recognized by Rogers and Fraley that by introducing claims to differentiated plants containing chimeric genes in the '568, '492 and '637 applications that Horsch should also be listed as an inventor in these applications until they were informed of that fact by their attorney in preparation of the preliminary statements and motions in the present interference.

8. Rogers and Fraley reviewed the '568 and '492 applications and executed declarations for those applications in the belief that these applications claimed only their contributions and that they were the sole inventors. It was not until it was explained by their attorney in review of the application for the interference that their mistake was recognized by them. This was the first time that it was recognized by the applicants that by amending the claims to include differentiated plants that the claims then included the contribution of Horsch and that it was necessary to change the inventive entity.

### **III. REASONS WHY THE REQUESTED RELIEF SHOULD BE GRANTED**

Correction of inventorship of an application should be granted as long as the error in naming the wrong inventorship occurred without any deceptive intention on the part of the actual inventors. 37 C.F.R. § 1.48(a). Indeed, if unclaimed subject matter is disclosed in an application that is invented by another, the application inventorship can be amended when the subject matter is

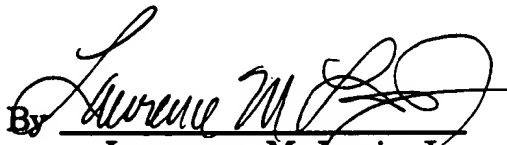
claimed. 37 C.F.R. § 1.48(c). Here, the contribution of Horsch had always been disclosed in the parent and continuation applications, but was not claimed until the '568 application was filed. Applicants recognized the contribution of Horsch in view of the '402 application, which had claims directed to a method of producing differentiated plants and differentiated plants per se. Applicants did not recognize that by amending the claims the inventorship should also be amended until this was explained to applicants by their attorney in preparation for the preliminary statement and motions.

The error thus arose without any deceptive intent on the part of the actual inventors as required by Rule 48. It is therefore requested that this motion should be granted.

#### IV. CONCLUSION

For the reasons set forth above, it is respectfully requested that the inventorship of the present application be amended to include Robert B. Horsch.

Respectfully submitted,

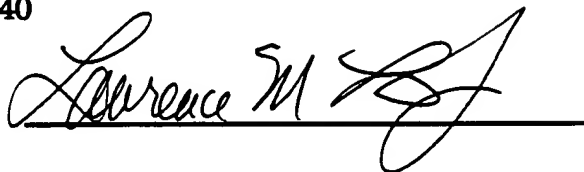
By   
Lawrence M. Lavin Jr.  
Lead Attorney for the  
Party Fraley et al.  
Reg. No. 30,768

Monsanto Company  
700 Chesterfield Parkway North  
St. Louis, Missouri 63198  
(314) 537-6670

**CERTIFICATE OF SERVICE**

It is hereby certified that a copy of the foregoing Fraley Motion No. 6  
was served by Federal Express on August 21, 1992 on:

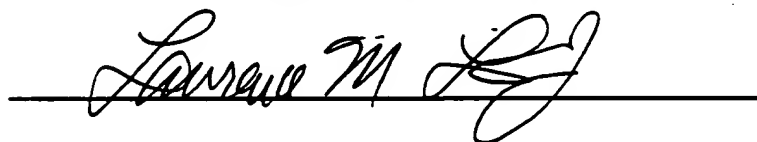
Richard D. Kelly  
1755 Jefferson Davis Highway  
Fourth Floor  
Arlington, Virginia 22202  
(703) 521-5940



Date: August 21, 1992

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being  
deposited with the United States Postal Service as  
first class mail in an envelope addressed to:  
Commissioner of Patents and Trademarks,  
Washington D.C., 20231 on August 21, 1992  
Lawrence M. Lavin, Jr.  
Registration No. 30,768

 Date: Aug 21, 1992



## **Motion 6**

### **Exhibit 1**

**SUBSTITUTE APPLICATION FOR UNITED STATES PATENT**  
**DECLARATION \* POWER OF ATTORNEY \* PETITION**

AS A BELOW-NAMED INVENTOR, I hereby declare that:

MY RESIDENCE, citizenship, and post office address are as stated below, next to my name.

I BELIEVE I am:

1. ☐ The original, first and sole inventor,
2. ☒ an original, first and joint inventor,

of the subject matter which is claimed and for which a patent is sought on the invention entitled:

3. CHIMERIC GENES FOR TRANSFORMING PLANT CELLS USING VIRAL PROMOTERS

the specification of which, with any Preliminary Amendments,

4. ☐ is attached hereto
5. ☒ was filed on December 7, 1990
- 5(a) as Application Serial No. 07/625,637
6. ☐ including Amendment(s) filed on
7. ☐ together with any Amendment(s) filed herewith.

I HEREBY STATE that I have reviewed and understand the contents of the above-identified specifications, including the Claims, as amended by any Amendment(s) referred to above.

I ACKNOWLEDGE my Duty to Disclose information of which I am aware which is material to the Examination of this Application in accordance with Title 37, Code of Federal Regulations, §1.56(a) including any such information which occurred between the filing date of any prior application listed below for which the benefit of Title 35, United States Code §120 is claimed and the filing date of this Application.

I HEREBY STATE that the subject matter which is claimed in any Amendment(s) referred to above was part of my or our invention and was invented before the filing of this Application.

BENEFIT OF EARLIER FILING DATE

THIS APPLICATION in whole or in part discloses and claims subject matter disclosed in and I hereby claim the benefit under title 35, United States Code, §120 of any of my or our prior United States Applications(s) listed below:

	<u>SERIAL NO.</u>	<u>FILING DATE</u>	<u>STATUS</u>
8.	458,414	January 17, 1983	Abandoned
	458,568	April 15, 1983	Abandoned
	931,492	November 17, 1986	Abandoned

I HEREBY CLAIM foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or Inventor's Certificate(s) listed below:

	<u>NUMBER</u>	<u>COUNTRY</u>	<u>FILING DATE</u>
9.			

Any foreign application(s) for patent or Inventor's Certificate(s) filed by me or us which claims or discloses all or any part of the subject matter claimed in this Application and which has a filing date before that of the above-listed application(s) on which foreign priority is claimed is identified below:

	<u>NUMBER</u>	<u>COUNTRY</u>	<u>FILING DATE</u>
10.			

AS TO ANY subject matter which is claimed in this Application which is not common to any above-identified prior application(s) for which the benefit of 35 U.S.C. §119 or §120 is claimed, I do not know and do not believe that the same was ever known or used in the United States before my or our invention or discovery thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the date of this Application, or in public use or on sale in the United States more than one year prior to the date of this Application, that said subject matter has not been patented or made the subject of an Inventor's Certificate issued before the date of this Application filed by me or my legal representatives or assigns more than twelve months prior to this Application.

AS TO ANY subject matter which is claimed in this Application which is common to any above-identified prior applications(s) for which the benefit of 35 U.S.C. §120 is claimed, I do not know and believe that the same was ever known or used in the United States before my or our invention or discovery thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the earliest of said prior application(s) to which said subject matter is common, or in public use or on sale in the United States more than one year prior to the earliest of said prior application(s) to which said subject matter is common, that said subject matter has not been patented or made the subject of an Inventor's Certificate issued before the date of the earliest of

said prior application(s) to which said subject matter is common in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months prior to the earliest of said prior applications(s) to which said subject matter is common.

11. ☐ ALL APPLICATION(S), if any, for patent or Inventor's Certificate on any part of said subject claimed in this Application filed by me or my representatives or assigns in any country foreign to the United States of America in addition to any listed above on which priority is claimed are listed in Annex A, attached hereto.

I HEREBY appoint the following as my attorney(s) and/or agent(s) of record with full power of substitution and revocation to prosecute this Application and to transact all business in the Patent and Trademark Office connected therewith.

- |     |                        |                 |
|-----|------------------------|-----------------|
| 12. | Lawrence M. Lavin, Jr. | Reg. No. 30,768 |
|     | Dennis R. Hoerner, Jr. | Reg. No. 30,914 |
|     | James C. Bolding       | Reg. No. 26,843 |

ALL correspondence/telephone calls in connection with this Application should be directed to:

13. Lawrence M. Lavin, Jr.  
Monsanto Company - BB4F  
700 Chesterfield Village Parkway  
St. Louis, Missouri 63198

- 13(a). Telephone Number: (314) 537-6670

I FURTHER declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the Application or any patent issuing thereon.

WHEREFORE, I PRAY that Letters Patent be granted to me solely or jointly with the additional inventor(s) (if any) named below for the invention described and claimed in the above-identified specification and claims, and I hereby subscribe my name to the above-identified specification and claims, Declaration, Power of Attorney and this Petition.

14(a). SOLE or FIRST JOINT INVENTOR,  
first name: ROBERT THOMAS FRALEY

RESIDENCE (State/Country) Missouri / U.S.A.

CITIZENSHIP: U.S.A.

POST OFFICE ADDRESS: 1048 Woodfield Estates  
Ballwin, Missouri 63011

INVENTOR'S SIGNATURE *Robert T. Fraley*

DATE: Aug 20, 1992

---

14(b). SECOND JOINT INVENTOR,  
(if any) full name: ROBERT BRUCE HORSCH

RESIDENCE (State/Country) Missouri / U.S.A.

CITIZENSHIP: U.S.A.

POST OFFICE ADDRESS: 12768 Whispering Hills Lane  
St. Louis, Missouri 63146

INVENTOR'S SIGNATURE *Robert Bruce Horsch*

DATE: August 20, 1992

---

14(c). THIRD JOINT INVENTOR,  
(if any) full name: STEPHEN GARY ROGERS

RESIDENCE (State/Country) Missouri / U.S.A.

CITIZENSHIP: U.S.A.

POST OFFICE ADDRESS: 4235 West Pine Boulevard #2  
St. Louis, Missouri 63108

INVENTOR'S SIGNATURE *Stephen G. Rogers*

DATE: August 19 1992

---

14(d). FOURTH JOINT INVENTOR,  
(if any) full name:

RESIDENCE (State/Country)

CITIZENSHIP:

POST OFFICE ADDRESS:

INVENTOR'S SIGNATURE \_\_\_\_\_

DATE: \_\_\_\_\_

## **Motion 6**

### **Exhibit 2**

**PATENT**  
38-21(10525)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF	)
Robert T. FRALEY et al.	)
SERIAL NO: 07/625,637	)
FILED: December 7, 1990	)
TITLE: CHIMERIC GENES FOR	)
TRANSFORMING PLANT	)
CELLS USING VIRAL	)
PROMOTERS	)

GROUP ART UNIT: 184

EXAMINER: David T. Fox

August 21, 1992

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
Commissioner of Patents and Trademarks,  
Washington D.C., 20231 on August 21, 1992  
Lawrence M. Lavin, Jr.  
Registration No. 30,768

 Date: Aug 21, 1992

**CONSENT OF ASSIGNEE**

Hon. Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

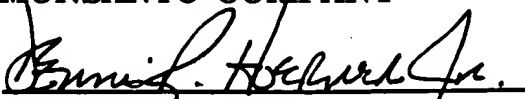
Sir:

Monsanto Company is the assignee of the above referenced application, as demonstrated by the assignment recorded February 24, 1987 at Reel No. 4673, Frame No. 843. Monsanto Company consents to the change of inventorship in this application from Robert T. Fraley and Stephen G. Rogers to Robert T. Fraley, Robert B. Horsch and Stephen G. Rogers.

Signed at St. Louis, State of Missouri, this 20th day of August, 1992.

MONSANTO COMPANY

By

  
Dennis R Hoerner  
Associate Patent Counsel

Monsanto Company  
800 North Lindbergh  
St. Louis, Missouri 63167


**PATENT**  
38-21(10525)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF	)	
	)	
Robert T. FRALEY et al.	)	GROUP ART UNIT: 184
	)	
SERIAL NO: 07/625,637	)	EXAMINER: David T. Fox
	)	
FILED: December 7, 1990	)	August 21, 1992
	)	
TITLE: CHIMERIC GENES FOR	)	
TRANSFORMING PLANT	)	
CELLS USING VIRAL	)	
PROMOTERS	)	

I hereby certify that this correspondence is being  
deposited with the United States Postal Service as  
first class mail in an envelope addressed to:  
Commissioner of Patents and Trademarks,  
Washington D.C., 20231 on August 21, 1992

Lawrence M. Lavin, Jr.  
Registration No. 80,768

 Date: Aug 21, 1992

**PETITION TO CORRECT INVENTORSHIP**

Hon. Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

Applicants hereby petition under 37 C.F.R. 1.48 to correct the inventorship of this application. Accompanying this petition is a Declaration of Robert T. Fraley and Stephen G. Rogers setting forth the the facts establishing when the error in naming the incorrect inventorship occurred and how it occurred, showing that it occurred without deceptive intention. Also accompanying this petition are a declaration by each of the actual inventors under 37 C.F.R. 1.63 and a written consent of the assignee.



Correction of inventorship of an application should be granted as long as the error in naming the wrong inventorship occurred without any deceptive intention on the part of the actual inventors. 37 C.F.R. § 1.48(a). Indeed, if unclaimed subject matter is disclosed in an application that is invented by another, the application inventorship can be amended when the subject matter is claimed. 37 C.F.R. § 1.48(c). Here, the contribution of Horsch had always been disclosed in the parent and continuation applications, but was not claimed until the '568 application was filed. Applicants recognized the contribution of Horsch in view of the '402 application, which had claims directed to a method of producing differentiated plants and differentiated plants per se. Applicants did not recognize that by amending the claims to include claims to differentiated plants that the inventorship should also be amended until this was explained to applicants by their attorney in preparation for the preliminary statement and motions in Interference 102,890.

The error thus arose without any deceptive intent on the part of the actual inventors as required by Rule 48. It is therefore requested that this motion should be granted.

## **Motion 6**

### **Exhibit 3**

MONSANTO

## Patent Department

**From** : Brian W. Nash - Brussels - Ext. 4866

---

**Date** : February 26, 1993

**cc** : J.C. Bolding (w/o)  
J.C. Hermans (w/o)  
D.R. Hoerner Jr.  
R.H. Shear  
H.C. Stanley

**Subj.** : EP 0 131 623 Chimeric Genes  
Ref. 07-21(132)A EP

**Ref.** : BWN/dh/93118

**To** : L.M. Lavin Jr.

Max Planck Gesellschaft has filed its observations in response to Monsanto Company's observations and has cited a new document viz PCT patent application WO 82/03087. I attach a copy of Max Planck's observations and the citation.

The EPO Opposition Division will not set a date for filing a reply, but it is normally worthwhile to file a reply because the EPO Opposition Division will read the reply and take it into account. I suggest you should draft a reply by the end of May 1993 so that we shall be able to review it and file it at the end of June 1993.

*Brian Nash*

Brian W. Nash

Enc.